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Serial No. : 10/623,112
Filed : July 18, 2003
Page : 14 of 27

Attorney Docket No.: 10664-166001

Amendments to the Drawings:

Please replace drawing sheets containing FIGs. 1 and 3 with the amended drawing sheets attached herewith.

Attachments following last page of this Amendment:

Replacement Sheet (2 pages)

Annotated Sheet Showing Change(s) (2 pages)

REMARKS

Claims 1-58 are pending in the action, with claims 1, 8, 15, 20, 24, 28, 33 and 53-58 being independent. Claims 2-4, 6-8, 10-15, 18, 20, 22-24, 26-29, 31, 33, 39, 41-47, 49 and 53-56 are amended. No new matter has been added.

The Examiner has objected to the drawings because the description with respect to Figs. 1 and 3 is inconsistent with the specification.

Claims 15-19 and 28-32 are rejected for allegedly being indefinite under 35 U.S.C. §112, ¶2.

Claims 1-3, 5-6, 8-10, 20-22 and 24-26 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by USP No. 6,023,723 to **McCormick**.

Claims 4, 7, 11-14, 23, 27, 33-49 and 53-58 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over **McCormick** in view of USP. 6,546,416 to **Kirsch**.

Claims 15-19, 28-32 and 50-52 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over **McCormick** in view of US Pub No. 2002/0184315 to **Earnest**.

Applicant respectfully traverses these rejections. Reconsideration and allowance of the above-referenced application are respectfully requested in light of the following comments and remarks.

Objections to the Drawings

The Examiner has objected to the drawings because the description with respect to Figs. 1 and 3 is inconsistent with the specification. In response, Applicant has amended both Figs. 1 and 3. In view of these amendments, Applicant respectfully requests that the objections to Figs. 1 and 3 be withdrawn.

Section 112, ¶2 Rejections

Claims 15-19 and 28-32 are rejected as allegedly being indefinite.

With respect to claims 15, 17, 28 and 30, the Examiner asserts that it is unclear what a "trend" is. *See*, page 3 of Office Action. Applicant respectfully disagrees with this conclusion.

As a preliminary matter, Applicant respectfully submits that while the Examiner has concluded that this term renders the rejected claims "vague and indefinite", the Examiner has not provided a basis in fact and/or cogent technical reasoning as to why one having ordinary skill in the art would not be able to ascertain the scope as defined by these claims, when reasonably interpreted in light of and consistent with the supporting specification.

Further, Applicant respectfully submits that the Examiner's inquiry as to what a trend is (or is not) is directed to claim scope rather than claim definiteness. As set forth in **M.P.E.P. § 2173.04**, claim breadth is not indefiniteness. Applicant respectfully asserts that there is no requirement that a claim must specify what each term is. Rather, the limits and boundaries of a claims must be clear. See, **M.P.E.P. § 2106 II(c)**. In this regard, Applicant respectfully directs the Examiner to Merriam-Webster's Collegiate Dictionary (10th Edition), which defines the term "trend" as "a general movement in the course of time of a statistically detectable change". See attached Exhibit A. Applicant also notes that the specification describes, in one implementation, that a trend can be determined by correlating messages. See, page 5, lines 3-5 of the specification. However, the pending claims are not limited to this implementation.

With respect to claims 16, 18, 29 and 31, the Examiner asserts that it is unclear what "unrelated email addresses" are. See, page 3 of Office Action. Once again, the Examiner has not provided a basis in fact as to why one having ordinary skill in the art would not be able to ascertain the scope of this phrase. In this regard, Applicant respectfully submits that the foregoing phrase may mean "email addresses that are unrelated".

Applicant respectfully reminds the Examiner that "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (*en banc*); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary meanings attributed to them by those of ordinary skill in the art.").

With respect to claims 19 and 32, the Examiner asserts that it is not clear what the relationship is between a threshold and a time dependent function. Applicant respectfully submits that these claims readily set forth what is required. As recited in these claims, a sender is determined to be a spammer if a number of messages sent to unrelated email addresses exceeds a time-dependent threshold. For example, a sender is determined to be a spammer if the sender has sent 10 messages to unrelated email addresses within 1 minute. As another example, a sender is determined to be a spammer if the sender has sent 500 messages to unrelated email addresses within 5 minutes.

Applicant respectfully reminds the Examiner that consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. §112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993); *North American Vaccine Inc., v. American Cyanamid Co.*, 7 F.3d 1571, 28 USPQ2d 1333 (Fed. Cir. 1993); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ (Fed. Cir. 1986). Applicant stresses that claims must be interpreted as one having ordinary skill in the art would have interpreted the claims in light of and consistent with the supporting specification. If one of skill in the art would readily understand the scope of the claims when read in light of the specification, and as repeatedly stated by the Federal Circuit, nothing more is required. "If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, 112 demands no more." *Credle v. Bond*, 25 F.3d 1556, 30 USPQ2d 1911 (Fed. Cir. 1994).

As Applicant believes that one having ordinary skill in the art who would have no difficulty in understanding the scope of the claimed invention(s) when reasonably interpreted in light of and consistent with the written description of the specification, Applicant respectfully requests that the rejection of claims 15-19 and 28-32 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Section 102(e) Rejections

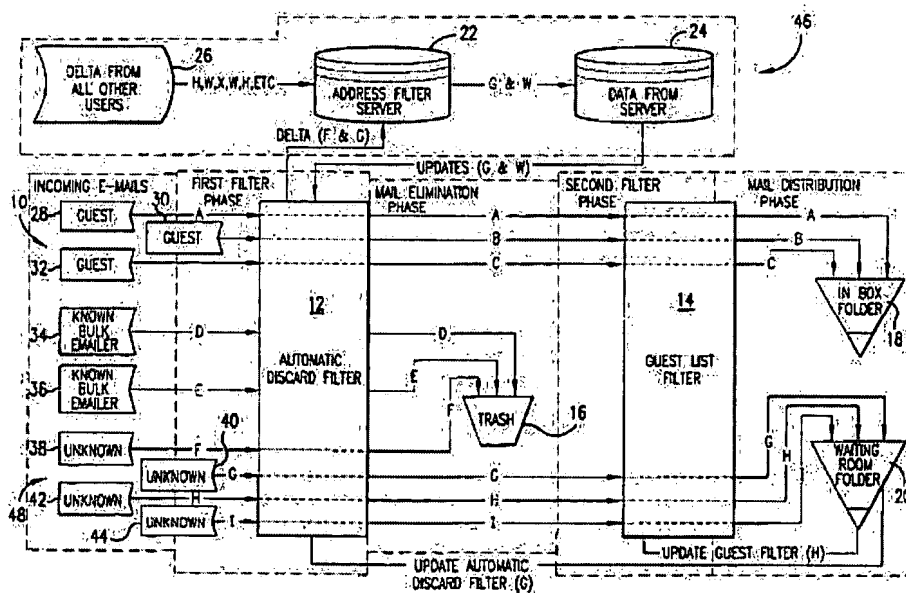
Claims 1-3, 5-6, 8-10, 20-22, and 24-26 are rejected as allegedly anticipated by

McCormick.

Claim 1 recites in part sharing a white list of confirmed message senders among a plurality of spam filters.

In the statement of rejection, the Examiner has identified McCormick's guest list as the claimed white list. *See*, page 4, 2nd paragraph of Office Action. Applicant respectfully submits that McCormick does not share this guest list among a plurality of spam filters.

McCormick describes an address filter system 10 for filtering junk emails. Each user of the system may establish individualized filters to prevent unwarranted email from being received (3:27-32).



Applicant respectfully submits that there is no disclosure in McCormick that may suggest that the guest list is shared among a plurality of spam filters. While McCormick describes downloading a current filter list to various users in the system (4:57-62), the current filter list identifies email addresses only in the "No Admittance" list, which bars unwarranted emails from being imported into the user's inbox folder 18 (4:20-25; 4:66-5:2). Email addresses specified in the guest list, however, are not downloaded to, shared with or distributed among other filters. Rather, McCormick's guest list is unique and local to each individual user, as it indicates the

particular entities from whom email messages are desired by the particular user. For example, as explicitly described in McCormick, the guest list allows an individual user to receive on-demand direct marketing information from third parties as well as promoting products for which the user has expressed interest (4:30-36), which may not be desired by other users. McCormick further emphasizes that the guest list filter 14 includes email addresses a user has **personally** added to the system (4:14-15) so that any email address contained in the guest list which matches an address of an incoming email would be automatically forwarded to the inbox folder 18 to be read by the user (4:26-29). As the email addresses contained in the guest list stored in the guest list filter 14 are personal and added to tailor a user's preference, Applicant respectfully submits that such a guest list is not the same as the claimed white list being shared among a plurality of spam filters.

Further, claim 1, as amended, recites that each of the confirmed message senders is authorized to send messages as evidenced by prior receipt of a response to a confirmation message. Applicant respectfully submits that McCormick's guests identified in the guest list are added based on a user's preference. McCormick's disclosure, however, does not specify that the guests in the guest list are authorized to send message as a result of a prior receipt of a response to a confirmation message.

For at least the foregoing reasons, Applicant respectfully submits that claim 1 is allowable. Claims 2-7 depend on claim 1, and also are submitted to be allowable for similar reasons discussed with respect to claim 1.

Claim 8

Claim 8 recites in part determining if a sender is included in a list of **confirmed senders** for any spam filter in the network.

As explicitly described in McCormick, email addresses of unauthorized sources filtered by the automatic discard filter 12 are periodically and automatically transmitted to the address filter server 22 provided at a remote central location 46 (4:43-51). These email addresses are then recorded on the current filter list, which is to be downloaded to various users in the system

(4:57-62).

The Examiner has identified McCormick's master list as being checked periodically to determine a sender as being a confirmed sender. See, page 5, lines 14-16 of Office Action. Applicant respectfully submits that the Examiner has mischaracterized McCormick's master list, as this master list contains email addresses being identified by the users as unauthorized sources, and is therefore sent to each user so as to allow the automatic discard filter 12, which filters junk email messages, to be updated (3:45-52). See, also, Abstract. This master list does not contain information or identification associated with any authorized sender or guest specified by the user.

For at least the foregoing reasons, Applicant respectfully submits that claim 8 is allowable. Claims 9-14 depend on claim 8, and also are submitted to be allowable for similar reasons discussed with respect to claim 8.

Claim 20

Claim 20 recites in part generating a list of **confirmed** message senders and maintaining the list at a data center.

The Examiner has identified McCormick's external remote central location 46 as storing a list of confirmed message senders. See, page 6, lines 4-8 of Office Action.

McCormick describes a remote central location 46, which includes a delta filter server 22 and a download server 24 (3:54-59). Applicant respectfully submits that neither the delta filter server 22 nor the download server 26 maintain a list of confirmed message senders. As described in McCormick, email addresses associated with unknown email messages filtered by the automatic discard filter 12 are periodically and automatically transmitted to the delta filter server 22 to be included in the current filter list (4:43-56). Incoming email messages matching the email addresses specified in the current filter list are discarded (5:11-15). That is, McCormick's delta filter server 22 is a server that maintains a list of **unauthorized** email addresses on which filtered email messages are based, and is not a server for maintaining information associated with **confirmed** message senders.

The download server 24 also does not maintain a list of confirmed message senders. As

indicated in McCormick, the download server 24, which is in communication with the delta filter server 22, downloads updated filter addresses to the various users in the system 10 by constructing an address packet consisting of every address on the current filter list (4:57-62). These "filter addresses", however, are the email addresses associated with unauthorized senders.

Further, claim 20 recites verifying with the data center that a sender of the message is a confirmed message sender. The Examiner asserts that McCormick verifies the master list stored in the remote central location 46. See, page 6, line 11 of Office Action.

Applicant, once again, respectfully submits that McCormick's remote central location 46 does not maintain information associated with confirmed message senders. Nor does the central location 46, for example, maintain email addresses specified in the guest list being stored in the guest list filter 14. Instead, incoming email messages are initially screened and removed by the automatic discard filter 12 (5:9-15), after which the guest list filter 14 retrieves email messages whose email addresses match those specified in the guest list. McCormick's system, however, does not verify with the remote central location 46 to determine whether a sender of a message is a confirmed message sender.

For at least the foregoing reasons, Applicant respectfully submits that claim 20 is allowable. Claims 21-23 depend on claim 20, and also are submitted to be allowable for similar reasons discussed with respect to claim 20.

Claim 24

Claim 24 recites in part verifying, at a data center coupled to the spam filters, the sender has been previously confirmed as a confirmed sender including determining if the sender is included in a list of confirmed senders associated with at least one spam filter in the network, the list being maintained at the data center. However, as discussed above with respect to claims 1 and 20, McCormick does not teach or suggest these features.

For at least the reasons set forth in claims 1 and 20, Applicant respectfully submits that claim 24 is allowable. Claims 25-27 depend on claim 24, and also are submitted to be allowable for similar reasons discussed with respect to claim 24.

Section 103(a) Rejections

Claims 4, 7, 11-14, 23, 27, 33-49 and 53-58 were rejected as allegedly unpatentable over **McCormick** in view of U.S. Patent No. 6,546,416 to **Kirsch**.

Claims 4 and 7 depend on claim 1, and also are submitted to be allowable for at least the reasons set forth with respect to claim 1.

Claims 11 and 14 depend on claim 8, and also are submitted to be allowable for at least the reasons set forth with respect to claim 8.

Claim 23 depends on claim 20, and also is submitted to be allowable for at least the reasons set forth with respect to claim 20.

Claim 27 depends on claim 24, and also is submitted to be allowable for at least the reasons set forth with respect to claim 24.

Claim 33

Claim 33 recites in part confirming that a message sender can receive one or more messages, and sharing information indicating that the message sender can receive among a plurality of spam filters in the messaging system.

Applicant respectfully submits that McCormick does not provide any disclosure or suggestion of confirming a message sender that the message sender can receive one or more messages, and sharing such confirmation with a plurality of spam filters. Specifically, McCormick does not confirm that the message senders specified in the "No Admittance" list or the guest senders specified in the "Guest List" can receive one or more messages. Information associated with the senders specified in both lists are downloaded to various users in the system 10 by the download server 24 regardless of whether these senders have been confirmed to receive one or more messages. As an example, as shown in Fig. 2, information associated with the unauthorized sender "free money" in the "No Admittance" list is shared among the users, even if this sender cannot receive messages. Since McCormick does not confirm whether a message sender can receive one or more messages, Applicant respectfully submits that McCormick also does not teach or suggest sharing such information among a plurality of spam

filters.

Kirsch does not cure the deficiencies in McCormick. In Kirsch, the email filter system 22 identifies and challenges email messages from correspondents that are not known to the system 22 (6:10-12). The challenge message may include a text statement and a digital signature, and request a specific response to the challenge message (6:23-29). If a validating response is received (7:18-21), the previously unknown email address is added to the "accept" list and the original message is then treated as a non-unsolicited commercial email message (7:32-35). Kirsch, however, does not provide any disclosure that the validated response or information associated with the now-validated unknown correspondent (e.g., email address) is shared with any entity or distributed among a plurality of spam filters.

For at least the foregoing reasons, Applicant respectfully submits that claim 33 is allowable. Claims 34-52 depend on claim 33, and also are submitted to be allowable for similar reasons discussed with respect to claim 33.

Claim 53

Claim 53 recites in part determining if the sender is a confirmed sender including querying a data center to determine if the sender is included in a list of confirmed senders based on information received from any of the spam filters in the messaging system, where confirmed senders are senders having a verified capability to receive messages.

However, as discussed above, McCormick does not teach or suggest these features. Kirsch does not cure the deficiencies in McCormick. Kirsch's email filter system 22 refers to the "accept" list to determine whether to accept or reject email messages received by the system 22 (6:6-10). The "accept" list is stored locally on the user system 14, which implements the email filter system 22 (5:33-37; 7:53-55). Kirsch's user system 14 does not query any data center, and certainly does not determine if a sender is a confirmed sender based on information received from any spam filter, as such information is readily available in the "accept" list.

For at least the foregoing reasons, Applicant respectfully submits that claim 53 is allowable.

Claim 54

Claim 54 recites in part determining if the sender is a confirmed sender, including querying a data center to determine if the sender is included in a list of confirmed senders based on information received from any of the spam filters in the messaging system, where confirmed senders are senders having a verified capability to receive messages.

As discussed above with respect to claim 53, neither McCormick nor Kirsch teach or suggest these features. For at least the foregoing reasons, Applicant respectfully submits that claim 54 is allowable for similar reasons discussed with respect to claim 53.

Claim 55

Claim 55 recites in part evaluating a list of confirmed senders, a confirmed sender being a sender having a verified capability to receive messages.

As discussed above, McCormick's list is a list pertaining to unauthorized senders, and is not a list that indicates information associated with confirmed senders. Kirsch does not cure these deficiencies in McCormick. Kirsch's "accept" list specifies the entities whose identification are known to the user (9:64-67). Kirsch does not provide any disclosure that the "accept" list includes senders who have a verified capability to receive messages.

Claim 55 further recites receiving a request from one of the spam filters in the messaging system to verify if a sender of a message is a confirmed sender, a confirmed sender being a sender having a verified capability to receive messages. The Examiner has acknowledged that McCormick does not teach or suggest these features. *See*, page 14, lines 3-12 of Office Action. Applicant respectfully submits that Kirsch does not cure these deficiencies in McCormick because Kirsch does not teach or suggest a plurality of spam filters, let alone receive a request from one of a plurality of spam filters.

For at least the foregoing reasons, Applicant respectfully submits that claim 55 is allowable.

Claim 56

Claim 56 recites in part receiving a request from one of the spam filters in the messaging system to verify if a sender of a message is a confirmed sender, a confirmed sender being a sender having a verified capability to receive messages, evaluating a list of confirmed senders, and sharing the sender's status with other spam filters in the messaging system.

As discussed above, neither McCormick nor Kirsch teach or suggest these features.

Further claim 56 recites confirming a sender including providing a notification to the sender if the sender is not included in the list of confirmed senders. As explicitly described in McCormick, email messages that have successfully passed through the automatic discard filter 12 but whose email addresses are not included in the guest list are transmitted to the waiting room folder 20 for user review (5:24-26; Abstract). Applicant respectfully submits that McCormick does not send any notification to a sender if the sender is not included in the guest list.

Kirsch does not cure the deficiencies in McCormick. In Kirsch, the challenge request is sent to a sender if the identity of the sender is not known (6:10-12). If a sender is not included in the list of confirmed senders based on the "accept" list, then Kirsch's email filter system rejects the message sent by the sender (6:6-10).

For at least the foregoing reasons, Applicant respectfully submits that claim 56 is allowable. Claims 57-58 depend on claim 56, and also are submitted to be allowable for reasons discussed with respect to claim 56.

Section 103(a) Rejections

Claims 15-19, 28-32 and 50-52 are rejected as allegedly unpatentable over **McCormick** in view of U.S. Pub No. 2002/0184315 to **Earnest**. Claim 15 recites in part determining a trend in the collected information relating to a sender.

In the statement of rejection, the Examiner has acknowledged that McCormick does not teach or suggest these features, but identified Earnest's operation 132 as disclosing a process of determining a trend. *See*, page 15, lines 18-20 of Office Action. Applicant respectfully disagrees with this conclusion. Earnest's operation 132 does nothing more than determining the

time (called "a seconds threshold") allotted to a sender for sending a number of messages. Messages are then analyzed and determined to be spam or non-spam based on, *inter alia*, the seconds threshold (§ [0043]). Applicant respectfully submits that Earnest's seconds threshold does not determine a trend. Earnest's seconds threshold indicates a time during which a sender can send a predetermined number of messages. For example, Earnest's system may allow a sender with an address "goofy@isp.com" to send up to one hundred messages in any one hour period before making the sender of this address a spam sender (§ [0046]). Clearly, no trend is determined from these messages.

For at least the foregoing reasons, Applicant respectfully submits that claim 15 is allowable. Claims 16-19 depend on claim 15, and also are submitted to be allowable for reasons discussed with respect to claim 15.

Claim 28

Claim 28 recites in part determining a trend in the collected information.

However, as discussed above with respect to claim 15, neither McCormick nor Earnest teach or suggest these features:

For at least the reasons set forth in claim 15, Applicant respectfully submits that claim 28 is allowable. Claims 29-32 depend on claim 28, and also are submitted to be allowable for similar reasons discussed with respect to claim 28.

Conclusion

Applicant respectfully requests that all pending claims be allowed.

By responding in the foregoing remarks only to particular positions taken by the Examiner, Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

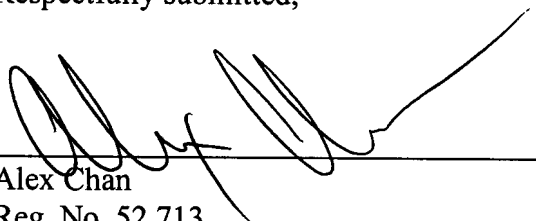
For all of the reasons set forth above, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 06-1050 and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: 8/17/07



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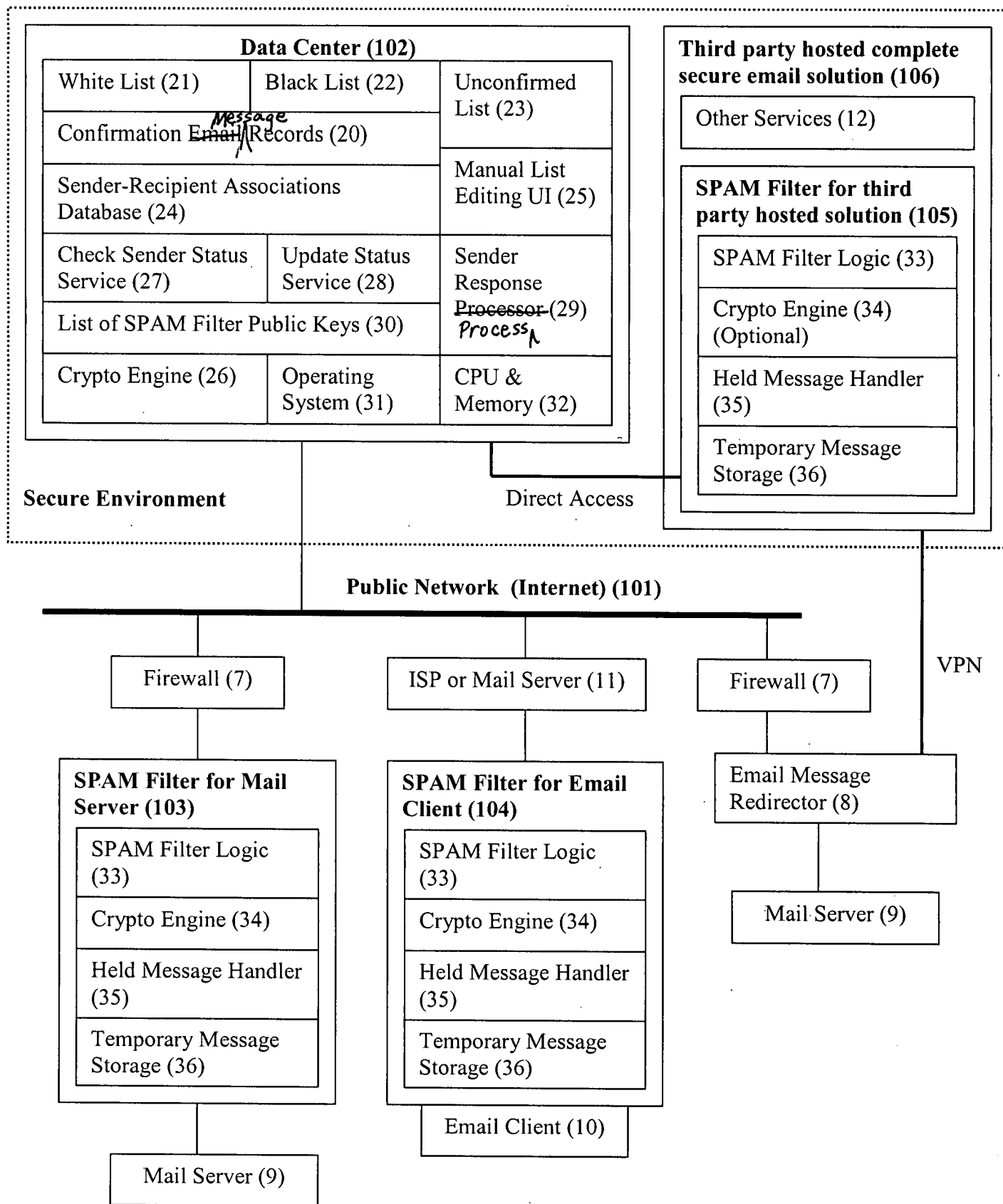


Figure 1

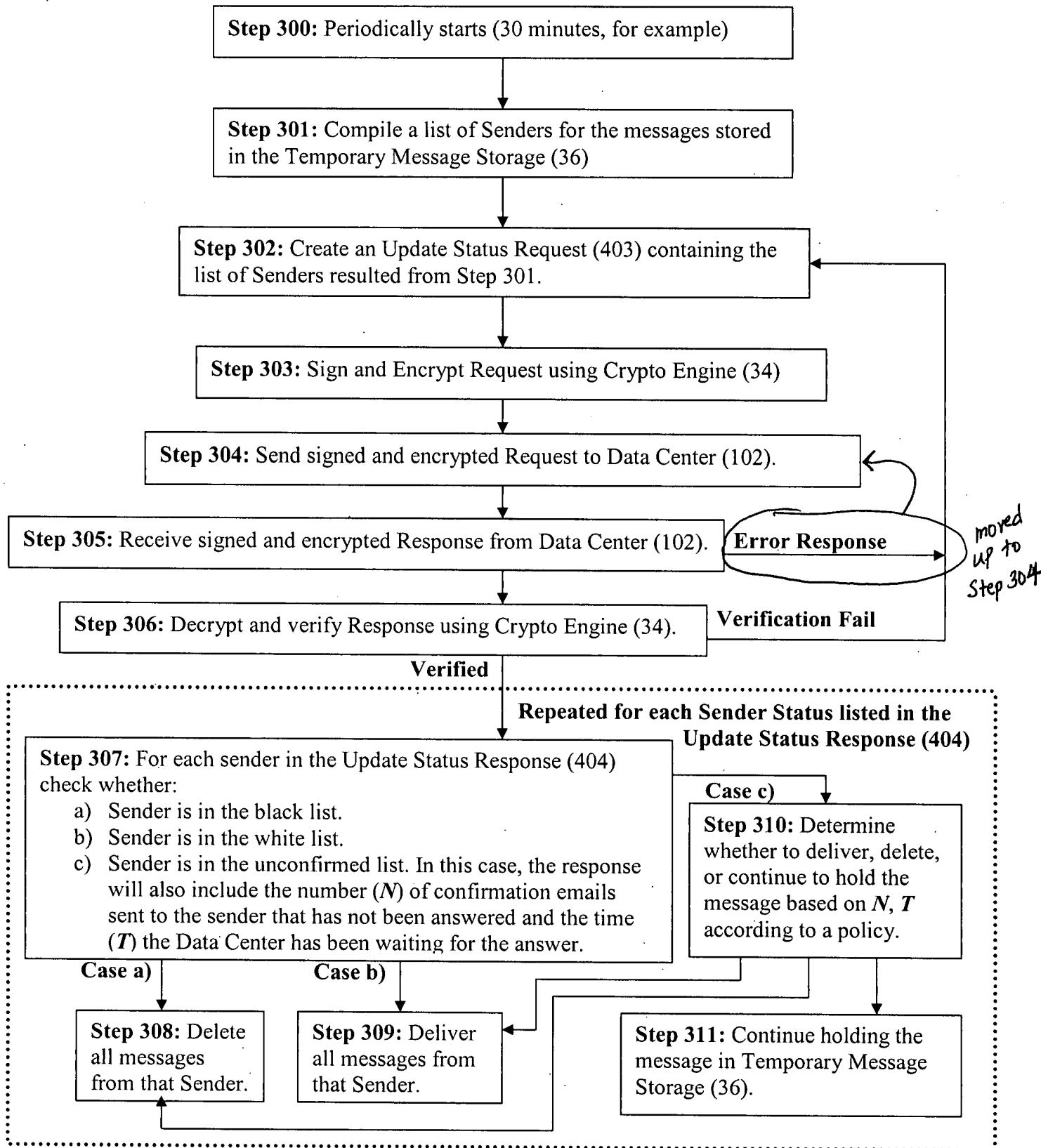


Figure 3